



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 12/758,204 | 04/12/2010 | Kodo Shu | 1004289.477US (4208-4533) | 4478 |
| 10928 | 7590 | 02/01/2017 | EXAMINER | |
| Locke Lord LLP IP Docket Department 3 World Financial Center New York, NY 10281-2101 | | | DEAN, RAYMOND S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2649 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 02/01/2017 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptopatentcommunication@lockelord.com
Shopkins@lockelord.com
Jmedina@lockelord.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KODO SHU

Appeal 2015-001880
Application 12/758,204
Technology Center 2600

Before ROBERT E. NAPPI, THU A. DANG, and JAMES R. HUGHES,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

Appellant has filed a Request for Rehearing under 37 C.F.R. § 41.52 (hereinafter “Request”) on December 27, 2016 for reconsideration of our affirmance of the Examiner’s rejection of claims 1–6, 8–18, and 20 in a Decision mailed December 21, 2016 (hereinafter “Decision”).

The Decision affirmed the Examiner’s 35 U.S.C. § 103(a) rejections of: 1) claims 1–6, and 9–18 over Eriksson, Frenger, and Henry; 2) claim 8 over Eriksson, Frenger, Henry, and Chaudhri; and 3) claim 20 over Eriksson, Frenger, Henry, and Minegishi.

We have reconsidered our Decision regarding claims 1–6, 8–18, and 20 in light of Appellant’s comments in the Request (Request 2–6). We grant the Rehearing Request to the extent that we consider the Appellant’s arguments *infra*, but DENY the request to modify our Decision. As noted *infra*, we are still of the view that the invention set forth in claims 1–6, 8–18, and 20 is unpatentable over the combined teachings of Eriksson, Frenger, and Henry (and Chaudhri or Minegishi) under 35 U.S.C. § 103(a). We incorporate our earlier Decision herein by reference. *See* 37 C.F.R. § 41.52(a)(1).

II. ISSUE

The issue we address in this Request is whether Appellant has persuasively identified that the Board misapplied the relevant law or misapprehended Appellant’s arguments set forth in the Appeal Brief in finding no error with the Examiner’s finding that the combination of Eriksson, Frenger, and Henry teaches or would have suggested computer program code configured to cause an apparatus to “generate a prioritised

radio channel selection list, in accordance with at least one predetermined selection criterion, for the at least one perimeter area,” the criterion “including availability of white-space channels” and “generate another prioritised radio channel selection list for the at least one inner area of the cell,” as recited in claim 1 (emphasis added).

III. ANALYSIS

In the Request, Appellant addresses “instances of what the Appellant believes to be the Board’s misapprehension or overlooking of the Appellant’s arguments in the Appeal Brief” regarding the combination of Eriksson, Frenger, and Henry (Request 2). In particular, Appellant points to page 24 of the Appeal Brief, as an argument that Appellant believes the Board to have overlooked:

The combination of Eriksson, Frenger, and Henry does not result in the Appellant's claimed invention. There is no disclosure or suggestion in the combination of Eriksson, Frenger, and Henry, of the Appellant's claimed generating a prioritized radio channel selection list, in accordance with at least one predetermined selection criterion, for the at least one perimeter area, the predetermined selection criterion including availability of white-space channels and configured to reduce the probability of the same channel being selected for use by a first radio device in the at least one perimeter area of the cell and by a second radio device in an adjacent cell. The apparatus may generate another prioritized radio channel selection list for the at least one inner area of the cell, wherein the another prioritized radio channel selection list is different from the prioritized radio channel selection list, as claimed by the Appellant.

(*Id.*, citing App. Br. at 24).

Further, Appellant also points to page 17 of the Appeal Brief as “evidence” that Appellant believes the Board to have overlooked:

Eriksson teaches local ranking (within a base station) of channels based on locally measuring signal strength and quality. The purpose of this is to avoid a fixed plan of frequencies. Thus, Eriksson teaches away from centralized network planning or generating channel selection lists elsewhere than in the base station. One of ordinary skill in the art would not have been motivated to substitute Frenger's receiving "cell specific resource priority weights" from a central node, in a network-wide fixed plan of frequencies, into the Eriksson network, because such a modification would destroy the advantage of avoiding a fixed plan of frequencies in the Eriksson network. The proposal made by the Final Office Action to make such a substitution, would destroy the advantage of the Eriksson network.

(Request 2–3, citing App. Br. at 17).

However, we note that the paragraph referenced by Appellant on page 24 of the Appeal Brief merely consists of repeating the claim language and the contention that “the another prioritized radio channel selection list is different from the prioritized radio channel selection list, as claimed by the Appellant” (Request 2, citing App. Br. at 24). Such form of conclusory argument (merely contending that the prior art is different) fails to comply with 37 C.F.R. § 41.37(c)(1)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”). That is, merely reciting the language of a particular claim and asserting the cited prior art reference does not teach or suggest the claim limitation, without more, fails to constitute a separate issue of patentability. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011). Accordingly, as set forth in our Decision, “on this record, and by the preponderance of evidence, we are not persuaded of error regarding the Examiner's underlying factual findings and ultimate legal conclusion of obviousness” of the claims over the combined teachings (Decision 10).

Furthermore, we note that the paragraph referenced by Appellant on page 17 of the Appeal Brief merely consists of attorney arguments that “[t]he proposal made by the Final Office Action to make such a substitution, would destroy the advantage of the Eriksson network” (Request 3, citing App. Br. at 17). However, our reviewing court guides that such mere attorney conclusory statements (that the combination “would destroy the advantage” (Request 3, App. Br. 17)) which are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); and *Ex parte Belinne*, 2009 WF 2477843, at *3–4 (BPAI Aug. 10, 2009) (informative). Thus, as we pointed out in our Decision, “Appellant has presented no evidence that combining the prior art techniques (generating prioritized lists and allocating white space channels) in the manner proffered by the Examiner would have been ‘uniquely challenging or difficult for one of ordinary skill in the art’” (Decision 9, emphasis added, citing *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)).

In our Decision, we addressed Appellant’s arguments as set forth in the Appeal Brief. Although Appellant added additional arguments in the Reply Brief in an attempt to cure the noted deficiencies in the Appeal Brief, because Appellant’s arguments could have been raised in the Appeal Brief but Appellant failed to do so, in our Decision, we deemed the arguments technically waived.

Thus, although Appellant contends that the Board overlooked Appellant’s arguments in the Reply Brief (Request 3–6), it is inappropriate for Appellant to discuss for the first time in the Reply Brief matters that could have been raised in the Appeal Brief. As the Board has found, “[t]he

failure to raise all issues and arguments diligently, in a timely fashion, has consequences,” and thus, such newly-raised arguments are technically waived. *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision) (“[The reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”). *Cf. Kaufman Company v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986) and *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986).

Nevertheless, as set forth in our Decision:

Appellant appears to view the combination in a different perspective than that of the Examiner. The issue here is not whether the skilled artisan would have bodily incorporated the entire system of Frenger into the entire system of Eriksson, and then combine the entire system of Henry thereto. That is, . . . the issue is whether the ordinarily skilled artisan, upon reading Frenger's prioritizing of channels for an inner area of the cell as well as the perimeter, would have found it obvious to generate a prioritized list for an inner area of a cell as well as the perimeter in Eriksson.

Similarly, . . . the issue is whether the ordinarily skilled artisan, upon reading Henry's use of white-space channel availability as a channel allocation criterion, would have found it obvious use white-space channel availability as a criterion in the generation of prioritized list in Eriksson.

We agree with the Examiner that one of ordinary skill in the art, upon reading Frenger's teaching of prioritizing for an inner area of a cell as well as the perimeter area of the cell . . . , would have found it obvious to modify Eriksson's generating a prioritized radio channel selection list . . . , to further “generate another prioritised radio channel selection list for the at least one inner area of the cell” as recited in claim 1

Similarly, we agree with the Examiner that it would have been obvious to combine Henry's teaching of a “known technique of

accessing a database containing cross-referenced information regarding white-space channels available” . . . to include white-space channel availability as a criterion in the system of Eriksson (Decision 9).

Accordingly, Appellant’s Request does not persuade us of any points we misapprehended or overlooked in the Decision.

On this record, Appellant has not identified that the Board has misapplied the relevant law or misapprehended Appellant’s arguments. We therefore maintain our affirmance of the Examiner’s rejection under 35 USC § 103(a) of claims 1–6, 8–18, and 20.

IV. CONCLUSION AND DECISION

We have considered the arguments raised by Appellant in the Request for Rehearing. Although we have considered our prior Decision in light of the Request for Rehearing, we decline to modify our prior Decision in any respect.

REHEARING DENIED